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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20070606

Application Number: 09/802,354

Filing Date: March 9, 2001

Appellant(s): Sunshine et al.

Michael D. Kaminski
(Reg. No. 32,904)
For Appellant

EXAMINER'S ANSWER

This examiner's answer has been prepared in response to appellant's brief on appeal filed December 29, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(*Smiths Detection , Inc.*)

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(None.)

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(Claims 1-8 and 56 are pending, rejected, and appealed.)

(Claims 9-55 have been cancelled.)

(Claims 57 and 58 remain pending, but stand withdrawn from further consideration.)

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(None.)

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal contained in the brief is correct:

- I. Claims 1-8 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolawa et al. (US 6,370,513).

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Evidence Relied Upon*

The following is a listing of the evidence (e.g., patents, publications, official notice, and admitted prior art) relied upon in the rejection of claims under appeal:

US 6,370,513

Kolawa et al.

4/2002

Official Notice

That receiving feedback/reviews of products from consumers is well known to those of ordinary skill in the art.

(9) *Grounds of Rejection*

- I. Claims 1-8 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolawa et al. (US 6,370,513).

Kolawa et al. disclose a system for recommending a consumer product selection across a network, the system comprising: a recommendation engine comprising a first module (portion of functional descriptive material) for determining a difference between a plurality of consumer products having a plurality of descriptors by differentiating between at least one descriptor of the consumer products and providing the difference to a computer module; a descriptor module (portion of functional descriptive material) for receiving human descriptor trait (HDT) descriptor input regarding the plurality of descriptors of at least a sampled consumer product from at least two independent nodes on the network; a second module (portion of functional descriptive material) coupled to the recommendation engine for sorting between each of the consumer products to form at least two classes of the consumer products; a third module (portion of functional descriptive material) coupled to the recommendation engine for determining, for each consumer product, a correlation between the at least two classes and each of the descriptors including the received HDT descriptor input, assigning a weighting term for each descriptor based upon the ability of each descriptor to sort between the at least two classes; and, a fourth module (portion of functional descriptive material) coupled to the recommendation engine for cooperatively operating on the weighting terms to provide a recommendation, but Kolawa et al. do not disclose that the descriptor module is configured to

receive descriptor input from at least two independent consumers, since the descriptor input is received from retailers, not consumers. However, receiving feedback/reviews of products from consumers is well known to those of ordinary skill in the art (e.g., survey cards, focus groups, etc.), and official notice to that effect is hereby taken. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Kolawa et al. so as to receive the descriptor input from two consumers rather than two retailers, as is well known to do, in order to characterize the consumer products more accurately relative to reflecting the opinions of other consumers, as opposed to having to extrapolate from the opinions of retailers to the opinions of consumers.

Regarding claims 2-3, the nature of the particular consumer product being recommended by the system (wine, perfume, etc.) has been deemed merely a "for use" application of the claimed invention, hence, afforded little patentable weight (Kolawa et al. do, however, disclose a wine embodiment).

Regarding claim 4, each of the descriptors of the system of Kolawa et al. is (inherently) either an intrinsic (non-extrinsic) descriptor or an extrinsic (non-intrinsic) descriptor.

Regarding claims 5-6, each of the descriptors of the system of Kolawa et al. is in digital format, and is (inherently) either streaming (non-static) or static (non-streaming).

Regarding claim 7, the system of Kolawa et al. utilizes cluster mapping to generate the correlations between the consumer products and the at least two classes (see, in particular, column 12, line 35, to column 13, line 14).

Regarding claim 8, the network 12 of the system of Kolawa et al. is the Internet.

Regarding claim 56, the recited functional language characterizing the nature of the particular non-functional descriptive material being operated on by the claimed apparatus has been deemed merely intended usage of the claimed invention, hence, afforded little patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See MPEP §§ 2114 and 2173.05(g).

(10) Response to Argument

I. Claims 1-8 and 56 are unpatentable under 35 U.S.C. 103(a) for being obvious over Kolawa et al. (US 6,370,513).

A. Regarding the argument that Kolawa et al. do not disclose “consumers” being the ones to post the human descriptive trait (HDT) input, the argument is irrelevant for being non-responsive to the actual rejection, since the rejection conceded and addressed the argued omission. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

B. Regarding the argument that the examiner has failed to provide a reference as evidence of what the examiner has found to be “well known” prior art, the argument has been disregarded as merely spurious, since challenging the existence of well known prior art by merely arguing that the fact is not supported by a reference, without stating for the record that the examiner is wrong or that applicant is without knowledge of the prior art teaching, does not constitute a proper traversal of the finding(s). Whereas any further traversal would no longer be seasonable, the object of the well known statement is therefore now taken to be admitted prior art. See MPEP § 2144.03.

C. Regarding the argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the knowledge generally available to one of ordinary skill in the art would include having the end users/customers post their evaluations/descriptions of the product, as other customers would tend to accept such opinions as having greater credibility for being less biased (i.e., not being the ones selling the product and profiting from the sales).

Additionally, note that the disclosure of a reference is considered to be that which a skilled artisan could take as its teachings *in combination* with his own knowledge of the

particular art. *In re Graves*, 36 USPQ2d 1697 (Fed. Cir. 1995); *In re Sasse*, 207 USPQ 107 (CCPA 1980); *In re Samour*, 197 USPQ 1 (CCPA 1978).

Furthermore, it has been held that the main test for the tenability of any conclusion of obviousness with respect to any proposed or hypothetical combination or modification of prior art knowledge is whether or not such a combination or modification could have been performed or implemented by any person of ordinary skill in the art seeking to solve the same problem, at the time of the invention, with neither undue experimentation, nor risk of unexpected results.

See *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379.

D. Regarding the argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(11) Related Proceeding(s) Appendix

No decision rendered by any court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For all of the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



6/6/07

Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627

GJOC

June 6, 2007

Appeal Conference Held:

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